

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Tapas Mukhopadhyay, *et al.*

Serial No.: 10/043,877


Filed: January 9, 2002

For: ANTIHELMINTHIC DRUGS AS A
TREATMENT FOR
HYPERPROLIFERATIVE DISEASES

Group Art Unit: 1642

Examiner: B. J. Fetterolf

Atty. Dkt. No.: INRP:095US

CERTIFICATE OF MAILING 37 C.F.R. 1.8	
I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date below:	
November 24, 2004	
Date	Monica A. De La Paz

PETITION UNDER 37 C.F.R. §1.47(a)

Mail Stop Petition

Commissioner for Patents

PO Box 1450

Alexandria, VA 22313-1450

Sir:

Applicants hereby petition under 37 C.F.R. §1.47(a) pursuant to the inability of Applicants to locate inventor Tapas Mukhopadhyay to participate in the execution of a declaration under 37 C.F.R. §1.131 to antedate a reference cited in an Office Action pertaining to the above-referenced application for patent. The Commissioner is hereby authorized to deduct the amount of the fee for this Petition under 37 C.F.R. §1.17(h), or any additional fees required for any reason relating to the enclosed materials, from Fulbright & Jaworski L.L.P. Account No.: 50-1212/INRP:095US.

Petitioners set forth the following facts demonstrating that Rule 47 status is proper. An Office Action (**Exhibit A**) pertaining to the above-referenced patent application, dated June 28, 2004, was received by Applicants. To antedate a reference cited in the Office Action, Applicants sought to submit a declaration of inventors Tapas Mukhopadhyay, Sunil Chada, Abner Mhashilkar, and Jack A. Roth, in accordance with 37 C.F.R. §1.131 to show reduction to practice of the claimed invention prior to the Davis reference cited in the Office Action (WO 00/41669). Applicants submitted a response to the Office Action on October 28, 2004 (**Exhibit B**), indicating that a declaration under 37 C.F.R. §1.131 to antedate the Davis reference was in preparation, and was forthcoming in a supplemental response. A draft of the declaration was prepared under the guidance of inventor Sunil Chada, and Applicants emailed a draft of the declaration to Tapas Mukhopadhyay for his input on October 28, 2004 (**Exhibit C**). In the email, Applicants indicated that they would like to submit the declaration to the U.S.P.T.O. in a supplemental response to the Office Action by November 4, 2004. The email was sent to the last known email address that Applicants had on file for Dr. Mukhopadhyay. No response was received from Dr. Mukhopadhyay. On November 3, 2004, Applicants emailed Dr. Mukhopadhyay at another email address that Sunil Chada had in his files (**Exhibit D**). In the email, Applicants indicated that they would like to file the executed declaration on Thursday, November 4, 2004. No response was received from Dr. Mukhopadhyay.

The last known address of Tapas Mukhopadhyay is at Panjab University in India. The last known contact information of Tapas Mukhopadhyay is summarized as follows:

Prof. Tapas Mukhopadhyay
Director, National Center for Genome Studies and Research
Sector 14

Panjab University

Chandigarh, 160014, INDIA

Tel: +91 172 53 4118

EMAIL: tmukhopa@pu.ac.in

tmukhopa@hotmail.com

Applicants attempted to call the telephone number shown above, but were unable to make connection with the University. On November 8, 2004, Applicants FED EXed Tapas Mukhopadhyay a copy of the declaration for his comment and signature. The cover letter to Tapas Mukhopadhyay (**Exhibit E**) indicated that a response to the Office Action had already been filed, and that Applicants indicated in their response that the executed declaration would be forthcoming in a supplemental response. Tapas Mukhopadhyay was instructed to review the draft declaration, and to provide any comments to Applicants, and to sign and FAX back the declaration if he had no additional comments. The FED EX order detail and tracking sheet (**Exhibit F**) indicated that the FED EX was delivered to Dr. Mukhopadhyay's last known address in India on November 16, 2004. No response has since been received by Applicants.

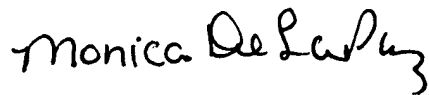
On November 23, 2004, Applicants contacted Examiner Brandon Fetterolf to request instruction as to how to proceed regarding filing a declaration under 37 C.F.R. §1.131 to antedate the Davis reference cited in the Office Action where one of the inventors cannot be located despite diligent efforts. Applicants were directed to the Manual of Patent Examining Procedure, §715.04. Section (C) of MPEP §715.04 indicates that "If a petition under 37 C.F.R. §1.47 was granted ..., the affidavit or declaration may be signed by the 37 C.F.R. §1.47 applicant or the legal representative, where appropriate." Applicants contacted the Office of Petitions, and were informed by Mr. Irving

Dengle that in order for Applicants to submit a declaration under 37 C.F.R. §1.131, Applicants must complete a Petition under 37 C.F.R. §1.47 to demonstrate the steps taken to identify Dr. Mukhopadhyay.

A copy of the declaration under 37 C.F.R. §1.131 (**Exhibit G**), executed by the three other inventors, Sunil Chada, Jack A. Roth, and Abner Mhashilkar, is provided herewith. Granting of the instant Petition is therefore necessary so that Applicants can submit a declaration of inventors under 37 C.F.R. §1.131 to antedate a reference cited in the Office Action dated June 28, 2004.

In view of the foregoing comments and attached documents, it is submitted that all of the requirements for granting of the instant Petition under 37 C.F.R. §1.47(a) have been satisfied and such action is respectfully requested.

Respectfully submitted,



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Date: November 24, 2004